

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 30, 2003. Reconsideration and allowance of the application and pending claims 1 – 23 are respectfully requested.

I. Rejections Under 35 U.S.C. §103 Should Be Withdrawn Because U.S. Patent No. 6,219,725 to Diehl *et al.* is Disqualified as Prior Art Under §103

The Office Action rejects claims 1 - 12 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 6,219,725 to Diehl *et al.* (“the ‘725 patent”) in view of U.S. Patent 5,038,297 to Hannah (“the ‘297 patent”). The Office Action rejects claims 13 – 17 and 19 – 21 under §103(a) as allegedly being unpatentable over the ‘725 patent in view of the ‘297 patent and further in view of U.S. Patent No. 6,067,382 to Maeda (“the ‘382 patent”). The Office Action rejects claims 18, 22, and 23 under §103(a) as allegedly being unpatentable over the ‘725 patent in view of the ‘297 patent and the ‘382 patent and further in view of U.S. Patent No. 5,544,306 to Deering *et al.* (“the ‘306 patent”). In this regard, Applicants note that all outstanding claim rejections are based on §103 AND rely on the ‘725 patent as the primary reference.

Applicants respectfully submit that the rejections under §103 should be withdrawn and claims 1 – 23 should be allowed for at least the reason that the ‘725 patent (which is used as the primary reference in all rejections) is legally excluded as prior art under §103.

In accordance with MPEP 706.02(1)(1), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. §103 via 35 U.S.C. §102(e) is disqualified as prior art against the claimed invention if that subject matter and the

claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." In this regard, Applicants submit that the '725 patent is only available as prior art under §102(e). Applicants note that the '725 patent issued April 17, 2001 from an application that was filed August 28, 1998. The present application was filed May 30, 2000. Therefore, the '725 patent is only available as prior art under §102(e).

Furthermore, Applicants submit that the present application and the '725 patent were, at the time the present invention was made, both owned by Hewlett-Packard Company. The Examiner may confirm that the present application and the '725 patent were commonly assigned at the time the present application was made by checking the records maintained at the Patent & Trademark Office and referring to the Assignment filed in the present application. Therefore, because the '725 patent is only available as prior art under §102(e) and because the present application and the '725 patent were both owned by Hewlett-Packard Company at the time the present invention was made, the '725 patent is disqualified as prior art. Accordingly, all outstanding rejections under §103 (each of which rely on the '725 patent) should be withdrawn and pending claims 1 – 23 be allowed.



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